



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,603	11/23/2001	Brett P. Giroir	29715/35152R	2243

4743 7590 01/16/2004

MARSHALL, GERSTEIN & BORUN LLP
6300 SEARS TOWER
233 S. WACKER DRIVE
CHICAGO, IL 60606

EXAMINER

MOHAMED, ABDEL A

ART UNIT PAPER NUMBER

1653

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,603

Applicant(s)

GIROIR ET AL.

Examiner

Abdel A. Mohamed

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

ACKNOWLEDGMENT TO APPLICANT'S RESPONSE AND THE STATUS OF THE CLAIMS

1. The response filed 9/22/03 to the Office action of 3/8/03 (Paper No. 6) is acknowledged, entered and considered. Claims 1-9 are present for examination. The rejection under U.S.C. 251 for defective reissue oath or declaration is maintained for the reasons of record.

ARGUMENTS ARE NOT PERSUASIVE

2. Applicant's arguments filed 9/22/03 have been fully considered but they are not persuasive. Applicant has argued that the rejection of the Reissue Application should be withdrawn because it is the term itself of the patent which is, through error and without deceptive intent, partly inoperative as a consequence of the addition of an unnecessary priority claim. In the present case it is the term itself of the patent which is partly inoperative as a consequence of the Applicant claiming more or less priority than was necessary. It is therefore submitted that reissue is an appropriate vehicle for correction of that defect is unpersuasive. Contrary to Applicant's arguments the Examiner has clearly indicated in the previous Office action that the identified "error" is not appropriate error as reiterated below:

**DEFECTIVE REISSUE OATH/DECLARATION, 37 CFR 1.175(a)(1)-THE IDENTIFIED
“ERROR” IS NOT APPROPRIATE ERROR**

3. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Patentees request that a reissue application has been filed to remove a claimed priority benefit under 35 U.S.C. 120. The patentee is making this correction in order to extend the term of the original patent by stating that the original patent to be partly inoperative or invalid because patentee claimed less than patentee had the right to claim in the patent. The patentee states that application (U.S. Ser. No. 09/203,159) now U.S. Patent No. 5,990,086 incorrectly made reference to prior copending applications. The applications are U.S. Ser. No. 08/378,228, filed 1/24/95, U.S. Ser. No. 08/291,112, filed 8/16/94, and U.S. Ser. No. 08/188,221, filed 1/24/94 and should not have been relied upon for priority. By including the additional early applications, the term of '086 patent has been reduced. Removing these applications from the priority claim, the reissue patent issuing from the present reissue application should be granted a patent term 2 years and 3½ months extended beyond that of the original patent. By removal of priority claim(s) under 35 U.S.C. 120, the filing and effective date of U.S. Ser. No. 09/203,159 (U.S. Patent No. 5,990,086) would be December 1, 1998.

Based under 35 U.S.C. 251, the patentee has the right to claim upon surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended

application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue. Thus, patentees request for extending the reissue application patent term beyond that of the original patent (i.e., '086 patent) term is improper because 35 U.S.C. 251 only permits reissue for the unexpired part of the term of the original patent.

REJECTION, DEFECTIVE REISSUE OATH OR DECLARATION

4. Claims 1-9 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

ACTION IS FINAL

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


CONCLUSION AND FUTURE CORRESPONDENCE


6. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed whose telephone number is (703) 308-3966. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00 p.m. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (703) 308-2923. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications and (703) 305-7401 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


ROBERT A. WAX
PRIMARY EXAMINER

 Mohamed/AAM

January 5, 2004